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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/046,821	01/17/2002	Hiroki Takaoka	725.1152	5336

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EXAMINER

O'CONNOR, GERALD J

ART UNIT PAPER NUMBER

3627

DATE MAILED: 01/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/046,821

Applicant(s)

Takaoka et al.

Examiner

O'Connor

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on November 3, 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2, 8-14, 22, 23, and 25 is/are pending in the application.
- 4a) Of the above claim(s) none is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 8-14, 22, 23, and 25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on January 17, 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Preliminary Remarks

1. This Office action responds to the arguments filed by applicant on November 3, 2005, in reply to the previous Office action, mailed August 12, 2005.

Claim Rejections - 35 USC § 101

2. The following is a quotation of 35 U.S.C. 101:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claim 23 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 23 is drawn to a computer program *per se*. Computer programs *per se* intrinsically require no tangible physical structure, thus do not constitute tangible physical articles or other forms of matter. Therefore, computer programs *per se* are not considered to be statutory subject matter. To be statutory, a computer program must be: (1) coupled with or combined with some statutory physical structure, *and*, (2) produce or effect some useful, concrete, and tangible result.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

5. Claims 1, 2, 8, 10-14, 22, 23, and 25 are rejected under 35 U.S.C. 102(e) as being anticipated by Wolfe et al. (US 6,282,517).

Wolfe et al. disclose an estimated price providing method and apparatus for an automobile comprising: a first database in which an automobile manufacturer's suggested retail prices are registered in advance for respective predetermined automobile specifications that the automobile manufacturer can supply; at least one second database that includes an automobile dealer's estimated prices that are registered in advance for automobile specifications corresponding to the respective predetermined automobile specifications; customize means for allowing a user of an information terminal connected to said estimated price providing apparatus via a communication line to select an automobile of desired specifications in accordance with the respective predetermined automobile specifications by operations from the information terminal;

first price providing means for referring to said first database and transmitting the manufacturer's suggested retail price for an automobile of desired specifications selected by said customize means to the information terminal; dealer select means for allowing the user to select the automobile dealer by operations from the information terminal after the first price providing means transmits the manufacturer's suggested retail price; and, second price providing means for transmitting an estimated price of the automobile dealer selected by said dealer select means for the automobile of desired specifications when the automobile dealer is selected by said dealer select means and transmitting the desired specifications selected by said customize means to the information terminal in a name for the automobile dealer selected by said dealer select means.

Regarding claims 2 and 22, the method and apparatus of Wolfe et al. comprises the second price providing means providing the estimated price via e-mail of which e-mail address of its sender is the automobile dealer selected by the dealer select means, it being inherent that the e-mail from the dealer selected by the user being sent to the user would specify the dealer from whom it was sent.

Regarding claim 8, the apparatus of Wolfe et al. further comprises means for providing all estimated prices of the automobile of desired specifications, which were previously provided to the user, to be able to be displayed as a list on the information terminal in response to a query request by the user at the information terminal, it being inherent that the e-mail messages from the various dealers respectively containing each dealer's estimated prices of the automobile of desired specifications would be able to be stored and displayed as a list in the e-mail inbox and/or the e-mail server of the user.

Regarding claims 10-12, the apparatus of Wolfe et al. further comprises an estimated price updated means for permitting to browse and/or update the automobile dealer's estimated prices of said at least one second database in response to a request from the automobile dealer corresponding to said at least one second database, and denying update access of said at least one second database by either the automobile manufacturer or by another automobile dealer that does not correspond to said at least one second database.

Regarding claims 13 and 14, the customize means of the apparatus of Wolfe et al. executes a selection of drive system components that form a backbone of the automobile which can be manufactured by the automobile manufacturer, and then said customize means executes a selection of additional peripheral components appropriate/compatible with the components previously selected, the components being registered in advance in correspondence with the selected drive system components, but, in any event, the recited functional language characterizing the nature of the particular non-functional descriptive material being operated on by the claimed apparatus has been deemed merely intended usage of the claimed invention, hence, afforded little patentable weight in distinguishing the claimed invention over the prior art. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See MPEP §2114.

Regarding claims 23 and 25, the estimated price providing apparatus of Wolfe et al. comprises a computer program instructing a computer to operate as an estimated price providing

apparatus, and the program code of the computer program that makes the computer operate as the estimated price providing apparatus is stored on a computer-readable medium.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wolfe et al. (US 6,282,517).

Wolfe et al. disclose an estimated price providing apparatus for an automobile, as applied above in the rejection of claim 1 under 35 U.S.C. 102(e), but Wolfe et al. fail to specifically disclose means for transferring an estimation request of a trade-in automobile to the automobile dealer selected by said dealer select function when the estimation request of the trade-in automobile is received from the user of the information terminal.

However, requesting a trade-in value estimate from a dealer from whom a buyer is considering buying a new car is certainly a well known, hence obvious, step to follow in the process of purchasing a new car, when one currently has a current car that they wish to replace with the new car.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the estimated price providing apparatus of Wolfe et al. so as to enable a user purchasing a new car by means of the apparatus to submit to the selected dealer a request for an estimation of a trade-in value of a trade-in automobile, as is well known to do in the conventional process of purchasing a car, in order to allow the user to best gauge the true net cost of purchasing the new car, since so doing could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

Response to Arguments

8. Applicant's arguments filed Nov. 3, 2005 have been fully considered but are not persuasive.
9. Regarding the argument that the "computer program" of claim 23 is statutory because it is combined with a computer, the argued recitation has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight when, as here, it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).
10. Regarding the argument that claim 23 is statutory because it produces a "useful, concrete, and tangible result," claim 23 is not statutory, and applicant is advised that producing a useful,

concrete, and tangible result alone, while indeed a necessary condition for statutory subject matter, is not a condition that is sufficient to solely render a claim statutory.

11. Regarding the argument that claim 23 is statutory because a computer program is a process, a computer program *per se*, is not a process, it is an abstract idea, thus is not statutory, as explained in the rejection.

12. Regarding the argument that the conditions required for a computer program to comprise statutory subject matter are “unlawful and ought to be withdrawn,” an examination of this application reveals that applicant is unfamiliar with patent prosecution. Whereas a lack of skill in this field usually acts as a liability in affording the maximum protection for the invention disclosed, applicant is advised to secure the services of a knowledgeable, registered patent attorney/agent to prosecute the application, since the value of a patent is largely dependent upon skillful preparation and prosecution. The Office cannot aid in selecting an attorney or agent.

Applicant is advised of the availability of the publication “Attorneys and Agents Registered to Practice Before the U.S. Patent and Trademark Office.” This publication is for sale by the Superintendent of Documents, U.S. Government Printing Office, Washington, DC 20402, and is also currently available online at:

<http://www.uspto.gov/web/offices/dcom/olia/oed/roster/region/index.html>.

13. Regarding the argument that Wolfe et al. fail to disclose dealer select means for allowing the user to select the automobile dealer by operations from the information terminal after the first price providing means transmits the manufacturer's suggested retail price, Wolfe et al. indeed disclose dealer select means for allowing the user to select the automobile dealer by operations from the information terminal after the first price providing means transmits the manufacturer's suggested retail price. See, in particular, column 13, lines 8-11.

14. Regarding the argument that Wolfe et al. fail to disclose first price providing means for referring to the first database and transmitting the manufacturer's suggested retail price for an automobile of desired specifications selected by the customize means to the information terminal, Wolfe et al. indeed disclose first price providing means for referring to the first database and transmitting the manufacturer's suggested retail price for an automobile of desired specifications selected by the customize means to the information terminal. See, in particular, Figure 16, item 410 in Figure 4, and the detailed description from column 8, line 60, to column 9, line 29.

15. Regarding the argument that Wolfe et al. fail to disclose second price providing means for transmitting an estimated price of the automobile dealer selected by the dealer select means for the automobile of desired specifications ... and transmitting the desired specifications selected by the customize means to the information terminal in a name for the automobile dealer selected by the dealer select means, Wolfe et al. indeed disclose second price providing means

for transmitting an estimated price of the automobile dealer selected by the dealer select means for the automobile of desired specifications ... and transmitting the desired specifications selected by the customize means to the information terminal in a name for the automobile dealer selected by the dealer select means. See, in particular, column 11, lines 20-24.

16. Additionally, please take notice that the disclosure of Wolfe et al. explicitly includes the disclosures of five additional co-pending and commonly owned applications filed on the same date, incorporated by reference in their entireties. See, in particular column 1, lines 5-27. The applications are identified by Wolfe et al. only by their attorney docket numbers, but, for applicant's convenience, applicant is hereby advised that their corresponding official numbers are, respectively: 09/232,188; 09/231,521; 6,922,674; 09/231,525; and, 09/231,415.

17. To the extent that applicant is arguing that the references applied in the rejection fail to use the same names for certain elements as the names used by applicant, the argument is irrelevant, as it is noted that the disclosure in a reference must show the claimed elements arranged in the same manner as in the claims, but need not be in the identical words as used in the claims in order to be anticipatory. See *In re Bond*, 15 USPQ2d 1566 (Fed. Cir. 1990).

Additionally, note that, during patent examination, the pending claims must be interpreted as broadly as their terms reasonably allow. See *In re Zletz*, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989).

Conclusion

18. The prior art made of record and not relied upon is considered pertinent to the disclosure.

19. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

20. Any inquiry concerning this communication, or earlier communications, should be directed to the examiner, **Jerry O'Connor**, whose telephone number is **(571) 272-6787**, and whose facsimile number is **(571) 273-6787**.

The examiner can normally be reached weekdays from 9:30 to 6:00.

If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Mr. Alexander Kalinowski, can be reached at **(571) 272-6771**.

Official replies to this Office action may be submitted by any *one* of fax, mail, or hand delivery. **Faxed replies are preferred and should be directed to (571) 273-8300.** Mailed replies should be addressed to "Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450." Hand delivered replies should be delivered to the "Customer Service Window, Randolph Building, 401 Dulany Street, Alexandria, VA 22314."

GJOC

January 10, 2006

A handwritten signature in black ink, appearing to read "GJOC", followed by a date stamp "1/10/06".

Gerald J. O'Connor

Primary Examiner

Group Art Unit 3627